

REMARKS

Claims 17 and 18 are all the claims pending in the application.

Claims 17 and 18 are supported by, for example, compound numbers 58 and 39, respectively. Accordingly, no question of new matter arises and entry of the amendment is requested, respectfully.

The first line of the specification has been amended to indicate that the parent application is a national stage of a PCT, as recognized in the Official Filing Receipt.

I. Restriction Requirement

Applicants recognize that the compound of claim 18 is not within the elected group wherein J is a substituted or unsubstituted benzothiophene ring. However, as the subject matter of the claims has been significantly narrowed, the Examiner is requested to examine claims 17 and 18 together. It is believed that this will be less of a burden on the Examiner than examining generic claims to the elected subject matter.

II. Claim Objections

Claims 7-11 were objected to under 37 C.F.R. § 1.75(c) as being improper multiple dependent claims.

The rejection is moot in view of the cancellation of claims 7-11.

III Claim Rejections Under 35 U.S.C. § 112, 1st Paragraph

Claims 13, 15 and 16 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

The rejection is moot in view of the cancellation of claims 13, 15 and 16.

IV. Claim Rejections Under 35 U.S.C. § 112, 2nd Paragraph

Claims 1-5 and 7-16 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Examiner stated that in claim 1, the definition of an “alkenylene having 1-7 carbon atoms” for the variable “A” is indefinite because an “alkenylene” must have at least 2 carbon atoms. Further, for claim 15, the Examiner stated that it is not possible to “prevent” and “treat.”

Claims 1-5 and 7-16 have been canceled. Accordingly, the rejection is moot.

Furthermore, these words and phrases are not used in claim 17 or 18.

V. Double Patenting Rejections

Claims 1-5 and 7-16 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 14, 29 and 30 of copending Application No. 10/474,334; claims 15, 16, 18, 19, 21 and 23-31 of copending Application No. 10/963,710; and claims 1-3, 5-7, 9 and 11-17 of copending Application No. 11/129,508.

The Examiner asserted that there is overlap between the claims of the present application and those of the co-pending applications.

Application No. 10/474,334

Both of the compounds of claims 17 and 18 are specifically claimed in claim 34 of the second preliminary amendment filed June 20, 2006 in the ‘334 application. However, since no allowable subject matter is indicated in either case, the Examiner is requested to hold this

rejection in abeyance. Further, should claims 17 and 18 be allowed, the rejection can be issued in the '334 application, which has a later priority date than that of the present application.

Application No. 10/963,710

As set forth in the Office Action, an obviousness-type double patenting rejection is a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper time wise extension of the "right to exclude." The doctrine is judicially created to reject claims over commonly assigned patents and applications that are not otherwise citable, because they are not legally effective prior art against the subject application. In the Office Action, the '710 application has been cited as prior art under 35 U.S.C. § 103(a). Accordingly, issuance of an obviousness-type double patenting rejection is legally improper and the rejection should be removed.

Furthermore, the compounds of claim 17 and claim 18 fall within the claims the '710 application when R¹ and R² are hydrogen, A is an ethylene group, E is COOH, G is a methylene group, m is 0 and J is a substituted benzothienyl group or a substituted N-methylindolyl group. However, as demonstrated in the declaration under 37 C.F.R. § 1.132, submitted herewith, and discussed below in the context of the statutory rejections, the compounds of claim 17 and claim 18 have unexpectedly superior properties as compared to compounds that differ only in that the benzothienyl group is not substituted or the N-methylindolyl group is not substituted.

Accordingly, the Examiner is requested, respectfully, to reconsider and remove this rejection.

Application No. 11/129,508

The compounds of new claim 17 and 18 fall within the claims of the '508 application when R¹ and R² are hydrogen, A is an ethylene group, E is COOH, G is a methylene group, m is 0 and J is a substituted benzothienyl group or a substituted N-methylindolyl group. However, as demonstrated in the declaration under 37 C.F.R. § 1.132, submitted herewith, and discussed below in the context of the statutory rejections, the compounds of claims 17 and 18 have unexpectedly superior properties as compared to compounds that differ only in that the benzothienyl group is not substituted or the N-methylindolyl group is not substituted.

Accordingly, the Examiner is requested, respectfully, to reconsider and remove this rejection.

VI. Claim Rejections Under 35 U.S.C. § 102

Claims 1-3 and 7-16 were rejected under 35 U.S.C. § 102(a) as being anticipated by Matsumoto et al (CA 2,336,909).

CA '909 is the Canadian counterpart of copending Application No. 10/963,710. CA '909 does not specifically disclose either of the compounds of claim 17 or 18. Thus, CA '909 does not disclose each and every element of the present claims.

Accordingly, the Examiner is requested, respectfully, to reconsider and remove this rejection.

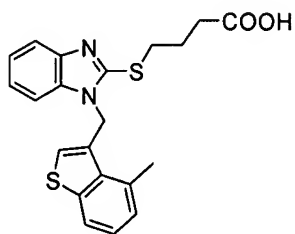
VII. Claim Rejections Under 35 U.S.C. § 103

Claims 1-5 and 7-16 were provisionally rejected under 35 U.S.C. § 103(a) as being obvious over copending Application No. 10/963,710, which has a common inventor with the instant application.

Claims 1-5 and 7-16 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto, et al. (CA 2,336,909), the Canadian counterpart of copending Application No. 10/963,710.

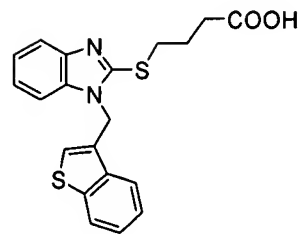
The compounds of new claims 17 and 18 are encompassed by the generic disclosure in copending '710 and in CA '909 if one picks and chooses the substituents such that R¹ and R² both are hydrogen, A is an ethylene group, E is COOH, G is a methylene group, m is 0 and J is a substituted benzothienyl group or a substituted N-methylindolyl group, respectively. However, as demonstrated in the declaration under 37 C.F.R. § 1.132, submitted herewith, the compounds of claims 17 and 18 have unexpectedly superior properties as compared to compounds that differ only in that the benzothienyl group or the N-methylindolyl group is not substituted.

More specifically, the ability to inhibit the activity of chymase and the metabolic rate were determined for the following four compounds.



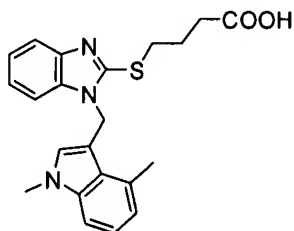
Compound A

Compound 58 in the Appln. No.: 10/777,067



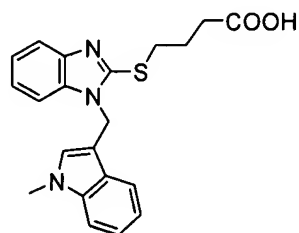
Compound B

Compound 459 in the Appln. No.: 10/963,710
Compound 52 in the Appln. No.: 10/777,067



Compound C

Compound 39 in the Appln. No.: 10/777,067



Compound D

Compound 460 in the Appln. No.: 10/963,710
Compound 34 in the Appln. No.: 10/777,067

Compound A and Compound C correspond to the compounds of claims 17 and 18, respectively. Compounds B and D, disclosed in both the '710 application and the corresponding CA '909 application, as well as in the present application, correspond to Compounds A and C, respectively, except that Compounds B and D lack the methyl substituent on the benzothiophenyl ring and the N-methylindolyl ring, respectively.

The results are shown in Table 1 of the Declaration (along with results disclosed in the '067 and '710 applications). The results show that the 4-substituted(methyl)-benzothiophene and -indole derivatives, Compounds A and C, respectively, have more potent chymase inhibitory

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No.: 10/777,067

Atty. Docket No.: Q79844

activity and lower metabolic rates than the corresponding non-substituted Compounds B and D.

Furthermore, the Declarants conclude that these results are unexpected.

Accordingly, any *prima facie* case of obviousness is overcome.

The Examiner is requested, respectfully, to reconsider and remove the rejections under 35 U.S.C. § 103(a).

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

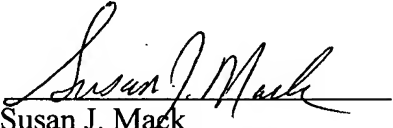
Respectfully submitted,

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